

NOMURA et al.

Appl. No. 09/892,747

Response to Office Action dated September 13, 2004

### REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

The specification has been amended to correct minor informalities. Entry of these amendments is respectfully requested.

Applicants respectfully request that the Examiner completely initial the PTO-1449 for the June 28, 2001 Information Disclosure Statement to evidence the consideration of JP 64-68058; JP 4-155566; and the Nomura application. Applicants also request that the documents identified in the Information Disclosure Statement filed on August 31, 2004 be considered and that an initialed PTO-1449 form be returned with the next office action to evidence this consideration.

Applicants also respectfully request that receipt of the certified copies of the two (2) priority documents be acknowledged. These documents were submitted on June 28, 2001 as evidenced by the copy of the postcard receipt stamped by the USPTO on this date.

Claims 1-7, 12-21, 23, 24, 26 and 27 were rejected under 35 U.S.C. Section 102(b) over Oki *et al.* (U.S. Patent No. 5,859,969). While not acquiescing in this rejection, claims 1-7, 12-14, 18-21, and 23 have been amended. As such, the discussion below makes reference to amended claims 1-7, 12-14, 18-21, and 23.

Oki *et al.* discloses a remote installation system and method for enabling a user of a terminal to obtain software through a communication line. In connection with the claims, the office action focuses on Oki *et al.*'s disclosure of "circumstance information" relating to "software operation circumstances" in the terminal, which circumstance information is provided to the distribution center. The office action alleges that the "circumstance file" corresponds to the claimed "operating environment" and that Oki *et al.* discloses the transmitting of this "operating environment" to the server before a program is supplied.

Claims 1, 12 and 21 variously recite a program supply method and system in which a program is executed on a user system after the program is supplied from a server and installed on the user system to thereby confirm operation of the program. This is described in connection with the illustrative example embodiments in which, for example, the control section 15 of the

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user terminal tries to execute the program. *See* page 22, lines 20-24. *See also* page 17, line 17 *et seq.*

Oki *et al.* fails to disclose confirming. In connection with this feature, the office action refers to Figure 5 of Oki *et al.* which purportedly shows "the confirming of decompression, moving/re-naming files and registration" and this is alleged to signify "the operation of the program." However, this portion of Oki *et al.* merely signifies completion of software installation, not confirmation that the newly installed software will operate when executed.

Because Oki *et al.* fails to disclose confirming operation of a program as specified in claims 1, 12 and 21, Oki *et al.* cannot anticipate these claims. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")

Claims 2-7 and 26 depend from claim 1 and claims 13-20 depend from claim 12. These claims are believed to be allowable because of this dependency and because of the additional patentable features recited therein.

Claims 23 and 24 likewise call for confirming the operation of a program and are therefore not anticipated by Oki *et al.* In addition, these claims also call for transmitting a notification of this operation confirmation to the server. Oki *et al.* does not disclose or suggest this feature. Here again, the confirming of decompression, moving/re-naming files and registration signify only the successful installation of a program. Such installation does not constitute a confirming that the program will operate or a transmitting of a notification of this confirming. For these additional and independent reason, claims 23 and 24 are believed to be allowable.

Claim 27 depends from claim 23 and believed to be allowable because of this dependency.

Claims 8-11, 22 and 25 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Oki *et al.* in view of Alexander *et al.* (U.S. Patent No. 6,134,593). While not acquiescing in this rejection, claims 8-11 have been amended. As such, the discussion below makes reference to amended claims 8-11.

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Oki *et al.* is acknowledged in the office action to lack disclosure of paying for a program after confirming the operation of the program as specified in claim 8, 22 and 25. To remedy this acknowledged deficiency, the office action references Alexander *et al.* which discloses a method for a user to order, unlock and pay for a software application using a password to gain access to the software. The office action contends that paying for a program after confirming that the program is operable in a user system is well-known as evidenced by Alexander. See 9/13/04 Office Action, page 10. In support of this contention, the office action refers to Alexander's disclosure of paying for the software at step 345 "after installing said software at 305."

However, Alexander *et al.* at col. 4, line 65 to col. 5, line 37 describes that the payment made in step 345 is for purchase of locked module 210b and there is no description in Alexander *et al.* of confirming operation of this program prior to this payment. Indeed, since module 210b is locked until payment is made, such confirmation is not possible. Consequently, Alexander *et al.* fails to disclose or suggest the concept of confirming that a program is operable in a user system prior to payment as set forth in claims 8, 22 and 25.

Claims 9-11 depend from claim 8 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

Claim 21 was rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Platt (U.S. Patent No. 5,421,009). Platt discloses a method of remotely installing software from a central location. Applicants find no disclosure in Platt of, for example, confirming that a program is operable in the user system as specified in claim 21. Consequently, claim 21 is believed to be allowable over Platt.

New claims 28-32 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added.

Claims 28-30 depend from claims 1, 12 and 21, respectively, and are believed to be allowable because of this dependency. These claims call for sending a confirmation to a server if operation of a program is confirmed by executing. Applicants submit that this feature is not disclosed or suggested by the applied references and thus claims 28-30 are believed to be allowable for this additional and independent reason.

Claim 31 is directed to a method performed by a user system to obtain a program from a server. The method comprises sending to the server operating environment data of the user

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system; receiving from the server a list of programs that is generated based on the operating environment data; sending to the server a request for one of the programs selected from the list; receiving the selected program from the server; installing the received program; executing the installed program to confirm its operation; and sending to the server a notification regarding the confirmation of operation. Applicants respectfully submit that the applied documents, taken either alone or in combination, do not disclose or suggest such a method. Accordingly, claim 31 and its dependent claim 32 are believed to be allowable.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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